

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

: APPLICANTS: Abbas M. Husain, M.D.
Arch C. Luther
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: SERIAL NO. 08/933,071
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: FILED: 9/18/97
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: FOR: DIGITAL AUDIO RECORDING
WITH COORDINATED
HANDWRITTEN NOTES
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: GROUP: 2876
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: EXAMINER: Daniel St.Cyr
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BRIEF OF APPELLANTS, ABBAS M. HUSAIN, M.D. AND ARCH C. LUTHER,
IN SUPPORT OF APPEAL FROM REJECTION OF CLAIMS 1 THROUGH 9
OF APPLICATION FOR PATENT NO. 08/933,071 FOR DIGITAL AUDIO
RECORDING WITH COORDINATED HANDWRITTEN NOTES

1. REAL PARTY IN INTEREST: The real parties in interest in this appeal and application are Abbas M. Husain, M.D. and Arch C. Luther, the inventors.

2. RELATED APPEALS AND INTERFERENCES: None.

3. STATUS OF CLAIMS: Claims 1 through 9 are pending. Claims 1 through 9 were rejected by Examiner Daniel St.Cyr in an Office Action dated March 2, 1999. The denial of Claims 1 through 9 is being appealed.

4. STATUS OF AMENDMENTS: Responsive to the Office Action dated March 2, 1999, appellants attempted to amend Claim 4. By Advisory Actions dated June 4 and June 25, 1999, Examiner St.Cyr advised that the proposed amendment would not be entered because

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the phrase "summarizing a content of the sound recording" in Claim 4 would require further consideration.

5. SUMMARY OF INVENTION: The present invention is an apparatus to enable the user to coordinate and correlate the sound recordings of meetings or transactions with notes of the meeting or transaction that have been taken on paper. The invention comprises a pick up and control unit identified in Fig. 1 and defined in Fig. 2 and Fig. 3 as being made up of a microphone 12, bar code reader 14, control panel 16, and interface unit 11 which are tied into a computer 1 through a selector 2, as shown in Fig. 1 and as described at page 6, line 19 through page 8, line 11 of the specification in the original application. As set forth at lines 10 through 12 at page 9 of the specification, "A key feature of this invention is that sound recordings cannot be made without first entering a bar code."

6. ISSUES: Were Claims 1 through 8 properly rejected under 35 U.S.C. 102(b) as being anticipated by Hoda, et al., U.S. Patent No. 4,831,610, and was Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Hoda, et al. In view of Bergeron, et al., U.S. Patent No. 5,126,543?

7. GROUPING OF CLAIMS: Appellants agree that Claims 1 through 8 either stand or fall together under the rejection premised upon 35 U.S.C. 102(b) and that Claim 9 stands or falls under the rejection premised upon 35 U.S.C. 103(a).

8. ARGUMENT: The examiner rejected Claims 1 through 8 under 35 U.S.C. 102(b) in the office action dated March 2, 1999

as being anticipated by Hoda, et al. It that office action, Examiner St.Cyr asserted:

Hoda et al disclose a method and apparatus for interactive control of a data recording medium playback apparatus using bar code access comprising: a disk storage 2 for recording a multiplicity of data wherein the data is audio (sound) and wherein the paper on which the identification code is printed contains written note [sic] representing in graphic form the content of the sound recorded; a memory 15 for storing a plurality of data, wherein the recorded and the stored data are retrievable using a unique identifying code 18 which assigned to the recorded and stored data during recording and storing sessions; a scanner 19 for scanning the identification code; a pickup 3 and control unit 13 (see figures 1 and 2; col.4, line 9 to col.5, line 42+).

While Hoda, et al. may in fact disclose some of the elements of the inventions claimed in Claims 1 through 8 of the instant application, Hoda does not disclose what is described at page 9, lines 10 through 12 of this application, as "a key feature of this invention . . ."; that being that the sound recordings cannot be made without first entering a bar code.

It is respectfully submitted that the examiner has been misled into thinking that the "code" referred to by Hoda as "bar code" is actually determined during recording. That is not the case. In fact, Hoda says nothing about how the values in the bar code are determined during recording. "A document having a bar code 18 printed thereon" is referenced at col.4, line 38 of Hoda. However, Hoda says nothing about how the values of the bar code are determined during recording.

The references to "code" and "frame numbers" referenced in Hoda, col.4, line 9 to col.5, line 42+ can easily lead to confusion. The "frame numbers" are referenced at col.4, line 68. The frame numbers are the only values determined during recording. In order to determine the "code", under Hoda, the "start" and "end" frame numbers must be determined. These are then the values that are placed into the bar code. Since there is no use of the bar code during recording, the determination of start and end frame numbers must be done manually, after recording, to obtain the values to put into the bar code. This tedious and error-prone process is completely eliminated by the invention disclosed in the application presently before this Board. The instant invention solves the coordination problem by using the bar code during recording to determine the identification for the recording that will automatically match the bar code to be used for the subsequent playback. It should be apparent therefore that Hoda, et al. do not disclose the key element which is claimed in the instant application and therefore there is no basis for rejecting Claims 1 through 8 under 35 U.S.C. 102(b) as being anticipated by Hoda, et al.

Claim 9 was rejected by the examiner under 35 U.S.C. 103(a) as being unpatentable over Hoda, et al. in view of Bergeron, et al., U.S. Patent No. 5,126,543. The examiner concedes that Hoda, et al. failed to disclose or fairly suggest a microphone device for picking up sound. The patent issued to Bergeron does deal with identification during the recording process and discloses a

combined microphone-bar code reader unit for that purpose. There is no suggestion in Bergeron that the bar code would be used to identify anything other than what was dictated and certainly no suggestion that the dictation would be correlated via bar code with other written materials. Bergeron discloses the coordinated use of a dictation device with a bar code for identifying the dictation with a particular patient by way of identification number.

Claim 9 is:

A system for coordinating and correlating sound recordings of meetings or transactions and notes written on paper taken during said meeting or transaction, comprising, in combination, a pick-up and control unit including at least one microphone device for picking up sound in the meeting room and a bar code with reader for reading identifying marks placed on note paper, a sound recording and storage device, said sound recording and storage device having means to identify the sound recorded and stored data with the notes written on paper.

Neither the patent issued to Hoda nor the patent issued to Bergeron disclose the integration of voice recording with notes on bar code identified paper. It is respectfully submitted that

nothing in Bergeron suggests or implies that its concepts be incorporated with those disclosed in Hoda. On the contrary, the application now before this Honorable Board discloses a system wherein the code reader 15 as shown in Fig. 3 of the application is part of a pick-up and control unit which ties into the recorder through a computer as shown in Fig. 2 of the application. That structure and arrangement is distinct from anything suggested by Hoda or Bergeron and therefore would not be obvious to persons of ordinary skill in the art at the time of the invention.

9. SUMMARY: For the reasons set forth above, it is respectfully requested that this Honorable Board reverse the determination of the examiner and enter an allowance of Claims 1 through 9 of the instant application.

Respectfully submitted,

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